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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/446,804	06/01/95	AMBROSIO	T PD0340K

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F3M1/0423

EXAMINER	
RACITI, E	
ART UNIT	PAPER NUMBER
3312	//

DATE MAILED:

04/23/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No. 08/446,804	Applicant(s) Thomas AMBROSIO et al.
Examiner Eric P. Raciti	Group Art Unit 3312

Responsive to communication(s) filed on Mar 22, 1996.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) 4-6 and 8-24 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-3 and 7 is/are rejected.

Claim(s) 25-27 is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2-12-96

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

5 Claims 4-6 and 8-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper Nos. 4 and 8 and petitioned in Paper No. 9. A decision adverse to Applicant was entered in Paper No. 10.

FORMAL MATTERS:

10 The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

15 It does not identify the foreign (PCT) application for patent on which priority is claimed pursuant to 37 C.F.R. § 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.¹

Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

20 The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

25 The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

IN THE CLAIMS:

¹ See MPEP § 1893.01(e)

Claims 2 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At line 7, "retainer means" lacks proper antecedent basis. Claim 7 contains multiple recitations lacking proper antecedent basis, as being dependent from a non-elected claim.

5 The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

10 *(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

15 *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

20 *Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.*

Claims 1-3 are rejected under 35 U.S.C. § 103/102(e) as being unpatentable over Ambrosio et al. (U.S. 5,243,970) in view of Altermatt et al. (U.S. 5,263,475). Ambrosio teaches an inhalator comprising: powder housing means (12) for holding a supply of powdered material to be dispensed; an inhalation conduit (Fig. 21) extending therethrough in a displaced relation; metering plate means (48) for holding a metered amount of said powdered material beneath the housing means (12); metered dose hole means (60) for holding said metered amount of said

powdered material; the metering plate means and the powder housing means being relatively bi-directionally rotatable with respect to each other about a common central axis (21); spring means (112) for biasing said metering plate means and said powder housing means toward each other to maintain contact therebetween; rotation limiting means (110); an upper support plate (64) positioned below and in contact with the metering plate means (48) and having an opening (76) larger than said metered dose hole means (60); a perforated plate element (100) secured to an underside of the upper support plate (64); a base (82) having a retaining post (68) extending therefrom; nozzle means (118) having cavity means (128) for changing the direction of flow; and swirl means (132), the outer wall (122) defining a shape substantially like an inverted tornado.

Ambrosio does not teach a counter. Altermatt teaches a counter means having a counter ring (121) means rotatable about a central axis; actuating means (Col. 17); and display means (Fig. 23); and locking means (Col. 18, ll. 5-9) to lock the inhaler after a predetermined number of doses. It would have been obvious to one of ordinary skill in the art to have provided the counter mechanism of Altermatt on the central axis of Ambrosio in order to provide indication of doses on the medicinal device.

Claims 7 and 25-27 are objected to for depending on a rejected claim, but would become allowable if rewritten in independent form to include all the limitations of itself, the base claim and any intervening claims, and in the case of claim 7, rewritten to conform to 35 U.S.C. § 112, 2¶.

The prior art made of record and not relied upon is considered pertinent to applicant's

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disclosure.

Rosskamp (U.S. 4,240,418), Elliott (U.S. 4,570,630), Brunet (U.S. 4,989,763), Smith (U.S. 5,069,204), and Evans (U.S. 5,161,524) teach inhalators.

Any inquiry concerning this communication or earlier communications from the Examiner
5 should be directed to Eric Raciti whose telephone number is (703) 308-0400. The Examiner may normally be reached between 9:00 AM and 5:30 PM EDT. The Fax number for Art Unit 3312 is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

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VINCENT MILLIN
S.P.E.
GROUP 3300

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E. P. Raciti
Examiner, AU 3312